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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/505,356

08/19/2004

Gerald J Julien

Ice US1

5987

7590
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05/27/2010

EXAMINER

WALTERS, JOHN DANIEL

ART UNIT

PAPER NUMBER

3618

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/505,356	Applicant(s) JULIEN, GERALD J	
	Examiner JOHN D. WALTERS	Art Unit 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-12 is/are allowed.
- 6) ☒ Claim(s) 1-4 and 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1 – 4 and 6 – 20 have been examined. Claim 5 has been canceled by Applicant.

Finality of the previous Office Action has been rescinded based upon the granted Petition, dated 19 May 2010. An action on the merits follows.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 4 and 13 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's disclosure in view of Abkowitz et al. (6,318,738) and Julien (WO9729892). Applicant's disclosure states that the following physical structures are "...conventional and are well known to those skilled in the art":

- a blade body having an ice contacting bottom edge (Fig. 1, item 30);
- said blade body having a structure for engaging a blade holder (Fig. 2, item 34);
- said bottom edge having opposed corners that are sharpened (Fig. 3);
- said blade holder being connected to a boot (Fig. 1).

Abkowitz discloses titanium composite skate blades comprising:

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- a titanium material blade, defined as any of the following: pure titanium, titanium alloys, or titanium matrix composites (column 2, lines 41 – 44).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to combine the old and well known blade structure with the titanium material of Abkowitz in order to provide improved strength, corrosion resistance, wear resistance and reduced weight (column 1, lines 59 – 62).

Abkowitz does not specifically disclose the use of Type 60 Nitinol, however, Julien discloses a blade comprising:

- an inter-metallic compound of about 60% nickel and about 40% titanium by weight (abstract).

Applicant lists many standard physical properties for “Type 60 Nitinol” within claims 1 – 4 and 13 – 20. Each material selected would provide differing physical properties, as these properties are dependent upon the physical and chemical structure of each individual material. It would have been obvious to one of ordinary skill in the art at the time the instant invention was made to make use of the material of Julien with the old and well known skate blade made from a titanium material, as taught by Abkowitz, in order to provide corrosion resistance, hardness, toughness and flexibility, (page 2 of 17, paragraph 10).

Allowable Subject Matter

Claims 6 - 12 are allowed.

Response to Arguments

Applicant's arguments filed within Applicant's Appeal Brief have been fully considered but they are not persuasive.

Appellant states, "Abkowitz specifies skate blade materials made of a titanium alloy 'which is reinforced by a hard constituent' (col 2, lines 5-6)...Abkowitz does not disclose or suggest the use of 60 Nitinol as a skate blade material, even though it was known long prior to the time of his invention."

While Appellant is correct in stating that Abkowitz specifies a very specific type of titanium composite, Abkowitz states, "As used herein, 'titanium material' refers to any titanium based material such as commercially pure titanium, titanium alloys and titanium matrix composites." It is clear that Abkowitz teaches that the inclusion of titanium within materials chosen for skate blades would be useful. One of ordinary skill in the art would be well within their skill and knowledge, in light of this teaching, to potentially manufacture a skate blade with any titanium containing material.

Appellant also states, "WO97/29,892...This reference makes a very good case for 60 Nitinol as a cutting instrument, but there is nothing in the disclosure or in the properties of 60 Nitinol as disclosed in this publication that would lead a person of ordinary skill in the art to make skate blades of 60 Nitinol."

This reference is not included to provide a teaching linking Type 60 Nitinol to the manufacture of skate blades. Abkowitz provides the teaching regarding the use of

titanium containing materials in the manufacture of skate blades. The Julian reference is provided as a showing that Type 60 Nitinol was known prior to the filing of the instant application. Appellant appears to be arguing the individual references of the combination rejection separately.

Appellant provides a long discussion on the Rule 132 Declaration provided by Susan Buchanan, President of Triumph Sport, Inc., licensee of the instant application. Abkowitz specifically and directly states that titanium alloys are appropriate materials for use in skate blades. This direct statement of applicability would lead one of ordinary skill in the art to consider and potentially pursue the use of a titanium alloy, such as one of the various formulations of Nitinol, in the construction of a skate blade. One cannot disregard the direct suggestion by Abkowitz to investigate the use of titanium and titanium alloys in the manufacture of skate blades.

The Rule 132 Declaration contains no data, only the opinion of an interested party. While Appellant provided a report commissioned by Triumph Sport, Inc., the report was neither published and introduced via an IDS nor submitted as a Rule 132 Declaration and thus has not been officially considered.

Regardless of its current status, the data contained within the report makes a comparison between a standard skate blade and the instant invention. For such data to be applicable it would need to be a direct comparison of the claimed invention with the closest prior art (i.e. Abkowitz) which is commensurate in scope with the claims, the results must be due to the claimed features not to unclaimed features and the burden

would be on the Appellant to establish that the results are in fact unexpected, unobvious and of statistical and practical significance. Were the report to be properly submitted, it still would fail to be a comparison with the closest prior art.

In Appellant's discussion of dependent claims 2, 3 and 14 - 20, no mention is made to the grounds of rejection listed above and in the prior rejections. Appellant repeatedly makes statements regarding what the Abkowitz and Julien references may or may not teach, but these references are not relied upon for the rejection of these claims. As stated above, Abkowitz is provide for the teaching of the use of a titanium containing material in skate blades and Julian is provided to show the existence of Type 60 Nitinol before the instant invention.

For this reason, the rejection stands.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Buehler et al. (3,174,851) disclose nickel-base alloys;
- Sahatjian (4,909,510) discloses a ports racquet netting;
- Murai (4,952,044) discloses a metallic eyeglass frame and method for making the same;

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- Wood (5,776,214) discloses a method for making abrasive grain and abrasive articles;
- Carpenter et al. (6,149,742) disclose a process for conditioning shape memory alloys;
- Johnson et al. (6,266,914) disclose spinner-type fishing lures and wire and cable fishing leaders.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN D. WALTERS whose telephone number is (571)272-8269. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on (571) 272-7742. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John D. Walters
Examiner
Art Unit 3618

/John D. Walters/
Examiner, Art Unit 3618